

REMARKS

Pursuant to the Office Action mailed on May 8, 2002, claims 1-3, 5-13, and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,821,515 to Kitahara ("Kitahara") in view of United States Patent No. 6,029,887 to Furuhashi et al. ("Furuhashi") and United States Patent No. 5,530,232 to Taylor ("Taylor"). By the foregoing amendment, the undersigned representative has amendment independent claim 13. Claims 1-3, 5-13, and 15-23 remain pending. In light of the aforementioned amendment and the remarks stated herein, the undersigned representative respectfully traverses the rejections stated above.

Rejection Under 35 U.S.C. 103

Independent claims 1 and 23 contain the limitations stated below:

1. (Amended) A method for controlling the reading from and writing to a multi-memory card comprising:
  - positioning a first memory of the multi-memory card within a first read/write component to facilitate reading from the first read/write component;
  - reading information from the first memory;
  - providing selectable functions in the form of a menu to a user;
  - receiving a first selected function, the first selected function having an associated second read/write component;
  - transporting the multi-memory card to the second read/write component according to the first selected function;
  - positioning a second memory of the multi-memory card within the second read/write component to facilitate reading from and writing to a second read/write component; and
  - performing the first selected function;

- displaying the results of the first selected function to the user;
- providing selectable functions to the user;
- receiving a second selected function, the second selected function having an associated third read/write component;
- transporting the multi-memory card to the third read/write component according to the second selected function;
- positioning a third memory of the multi-memory card within the third read/write component to facilitate reading from or writing thereto according to the second selected function; and
- reading from or writing to the third memory according to the second selected function.

23. (Amended) A system for controlling the reading from and writing to a multi-memory card comprising:

- means for positioning a first memory of the multi-memory card within a first read/write component to facilitate reading from the first read/write component;
- means for reading information from the first memory;
- means for providing selectable functions in the form of a menu to a user;
- means for receiving a first selected function, the first selected function having an associated second read/write component;
- means for transporting the multi-memory card to the second read/write component according to the first selected function;
- means for positioning a second memory of the multi-memory card within the second read/write component to facilitate reading from and writing to a second read/write component; and
- means for performing the first selected function;
- means for displaying the results of the first selected function to the user;
- means for providing selectable functions to the user;
- means for receiving a second selected function, the second selected function having an associated third read/write component;
- means for transporting the multi-memory card to the third read/write component according to the second selected function;
- means for positioning a third memory of the multi-memory card within the third read/write component to facilitate reading from or writing thereto according to the second selected function; and
- means for reading from or writing to the third memory according to the second selected function.

As is clearly seen from the verbatim recitation of independent claims 1 and 23, each of these claims recites, among other things, a first, second, and third memory as well as a first, second, and third read/write component. Further, claims 1 and 23 include specific functions that are performed by and between these memories and read/write components, as set forth in the claims. For example, the functional limitations recited in the claims, include, among other limitations, providing selectable functions, receiving a first and selected functions, transporting and positioning the multi-memory card to the required first, second or third read/write component according to the first and second selected function, and reading from or writing to the first, second, or third memory according to the first and second selected functions. There is no single reference or combination of references that teaches or suggests the combination of limitations recited in independent claims 1, 13 and 23.

In order to establish a *prima facie* case of non-obviousness as is required to support a rejection of the claims under 35 U.S.C. § 103, the Office must meet the following three requirements: (1) suggestion or motivation to modify the reference or to combine the reference teachings; (2) a reasonable expectation of success; and (3) **the prior art reference or references must teach or suggest all of the claim limitations**. See MPEP §2142 (emphasis added.)

In order to make the required showing, the Office has combined three different references. Kitahara discloses only two memories and only two recording/reading apparatuses. Kitahara is directed solely to the mechanical functioning of a hybrid card reader. Kitahara fails to **teach or suggest** at least a third memory and a third recording/reading apparatus in combination

with the first two memories and recording/reading apparatuses. Further, Kitahara fails to **teach or suggest** ANY of the functional limitations recited in the claims, such as, providing selectable functions, receiving a first and selected functions, transporting and positioning the multi-memory card to the required first, second or third read/write component according to the first and second selected function, and reading from or writing to the first, second, or third memory according to the first and second selected functions. Nor does Kitahara recite the means for performing these functions.

The Office admits on page 3 of the outstanding Office Action that Kitahara does not included a third read/write component, in addition to a first and second read/write component. In fact, Kitahara teaches away from the addition of either a third memory or a third read/write component, stating,

[w]hile in the above embodiment, the hybrid card 1 having the optical recording area 1A and IC chip 1B has been explained, the information recording and reproducing apparatus may be applied to a hybrid card combining a magnetic recording area and an IC chip. In this case, a magnetic head **is provided in place of the optical head 29** shown in FIGS. 1 and 3.

Column 10, ll. 5-11. Replacing is the opposite of adding. As indicated in MPEP 2144.05(III), “a prima facie case of obviousness [under 35 U.S.C. 103(a)] may also be rebutted by showing that the art, in any material respect, **teaches away** from the claimed invention.” (Emphasis added). Consequently, assuming, *arguendo*, that a *prima facie* case of unpatentability has been established, the undersigned representative hereby rebuts the finding since the Kithara reference teaches away from the claimed invention. It would not have been

obvious to “provide a third memory means in addition to the first and second memory of the card of Kithara” as stated by the Office. (Final Office Action, pg. 3)

The Office cites Furuhashi and Taylor in order to remedy the deficiencies of Kitahara. Furuhashi, while describing an IC chip, an optical recording medium, and a magnetic stripe, does not describe a first, second, and third read/write component. Further, Furuhashi fails to teach or suggest ANY of the functional limitations recited in the claims, such as, providing selectable functions, receiving a first and selected functions, transporting the multi-memory card to the required first, second or third read/write component according to the first and second selected function, and reading from or writing to the first, second, or third memory according to the first and second selected functions. Nor does Furuhashi recite the means for performing these functions. Furuhashi discloses separate uses for a multi-memory card. Furuhashi does not teach or suggest a multiple memory card that is used and transported according to user instructions between first, second, and third read/write components as set forth in independent claims 1 and 23.

Finally, Taylor also fails to remedy the deficiencies of Kitahara and Furuhashi. Taylor discloses a card having at most two memories. Taylor discloses using a single card reader/writer having separate read/write areas for reading/writing to one of the two memories, as shown in Figure 4. While the various reading/writing functions are presented to a user for selection for determining action on a single memory by a single read/write component, at no point does Taylor teach or suggest the following limitations of claims 1 and 23 wherein a user instructs a first read/write component to perform an action on a first

memory of a tri-memory card, the user is presented with selectable options, upon which selection of an option results in the transporting of the tri-memory card to a second read/write component to perform an action on a second memory of the tri-memory card. The card read/write components of Taylor are only available to read/write to a single type of memory and there is no teaching or suggesting of on-line transport between multiple read/write components pursuant to user selected functions.

Consequently, neither Kitahara, Furuhashi, nor Taylor, with alone or in combination, **teach or suggest all of the claim limitations** as is required to establish a *prima facie* case of unpatentability.

The undersigned representative has amended independent claim 13 to include an additional limitation that is not taught or suggested by the prior art. Support for the added limitation is found on page 9 of the specification. The undersigned representative respectfully asserts that the claims as presented herein are patentable over the references cited by the Examiner.

CONCLUSION

The undersigned representative respectfully submits that the claims presented herein are in condition for allowance in view of the cited prior art and earnestly request a notice of allowance to that effect. Should there be any further issues regarding prosecution of this case, please do not hesitate to contact the undersigned at the number provided below.

Respectfully submitted,

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**Marked-up Version of the Claims Showing Amendments**

13. (Amended) A system for controlling the reading from and writing to a multi-memory card comprising:

a read/write device including a magnetic read/write component, an optical read/write component, and an electronic read/write component for reading from or writing to a magnetic memory, an optical memory and an electronic memory of the multi-memory card;

a transport device connected to the read/write device for transporting the multi-memory card within the read/write device; and

a control device operatively coupled to the transport device and the read/write device for controlling the transport device and the read/write device, wherein the control device includes a processor; and

further wherein the control device generates a key at the electronic memory for encrypting writing on the optical memory.